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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,516	11/02/2001	Roger K. Debry	AM919970053US2	1210

7590 06/29/2004
Bracewell and Patterson L L P
Intellectual Property Law
P O Box 969
Austin, TX 78767-0969

EXAMINER

SMITHERS, MATTHEW

ART UNIT	PAPER NUMBER
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2137

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DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/004,516

Applicant(s)

DEBRY, ROGER K.

Examiner

Matthew B Smithers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed December 6, 2001 has been placed in the application file and the information referred to therein has been considered as to the merits.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-5 of U.S. Patent No. 6,314,521. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the patented claims and the application claims are directed towards a network device (printer, fax machine or modem) generating a

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request for a certificate from a certificate authority and subsequently receiving the requested certificate.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 5,164,988 granted to Matyas et al.

Regarding claim 8, Matyas discloses a network device (device A) with a unique ID and a secret (private) key embodied within the device (see column 13, lines 39-48), The network device makes a request to a certification center (digital authority) in order to receive a digital certificate (see column 14, line 51 to column 15, line 10; column 15, lines 24-26; column 15, lines 51-56 and column 16, lines 19-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,164,988 granted to Matyas et al as applied to claim 8 above, and further in view of U.S. patent 5,633,932 granted to Davis et al.

Regarding claim 9, Matyas discloses everything claimed as applied above (see claim 8), however Matyas fail to specifically teach the network device is a printer. Davis teaches a secure network system where a printing node (printer)(see column 1, lines 39-45) is one of the network devices that is certified by a local certifying authority (see column 4, lines 23-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Davis' apparatus for authenticating a printing device with Matyas' apparatus for enforcing security between networked devices for the purpose of preventing unauthorized access to sensitive information transmitted to a commonly used network device (see Davis; column 2, lines 26-40).

Regarding claim 10, Matyas discloses everything claimed as applied above (see claim 8), however Matyas fail to specifically teach the network device is a printer. Davis teaches a secure network system where a printing node (facsimile machine)(see column 1, lines 39-45) is one of the network devices that is certified by a local certifying authority (see column 4, lines 23-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Davis' apparatus for authenticating a printing device with Matyas' apparatus for enforcing security between networked devices for the purpose of preventing unauthorized access to sensitive information transmitted to a commonly used network device (see Davis; column 2, lines 26-40).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,164,988 granted to Matyas et al and U. S. patent 5,633,932 granted to Davis et al. and further in view of U.S. patent 5,692,048 granted to Gormish et al.

Regarding claim 11, Matyas et al. and Davis et al. discloses everything claimed as applied above (see claim 8), however, Matyas nor Davis specifically teach using a modem as the network device. Gormish teaches a communications network that uses a fax modem to securely transmit certified information (see column 4, line 33-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gormish's apparatus for sending certified facsimile transmissions and Davis' apparatus for authenticating a printing device with Matyas' apparatus for enforcing security between networked devices for the purpose of providing more capabilities in distributing secure information to destination sites.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B Smithers whose telephone number is (703) 308-9293. The examiner can normally be reached on Monday-Friday (9:00-5:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Matthew B Smithers
Primary Examiner
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